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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/733,212	12/11/2003	Donald W. Kufe	00530-095002 / 718.09	7998
26211	7590	07/25/2006		
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER HILL, KEVIN KAI	
			ART UNIT	PAPER NUMBER

1633

DATE MAILED: 07/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/733,212	Applicant(s) KUFE, DONALD W.	
	Examiner Kevin K. Hill, Ph.D.	Art Unit 1633	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

The continuing data of this application is not consistent with PTO records. The amendment to the specification filed December 11, 2003 regarding the filing date of U.S. Application No. 10/032,786, abandoned on January 5, 2004, is in error.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-8, drawn to a method of identifying a compound that inhibits binding of MUC1 to a tumor progressor, classified in class 436, subclass 501.

Should Applicant elect Invention I, a species election is required under 35 USC 121.

Currently, Claim 1 of this application is generic to a plurality of disclosed patentably distinct species comprising test agents that prohibit proper examination of this claim. Therefore, election is required under 35 U.S.C. 121 of one of inventions (i)-(v) below, regarding a patently distinct test agent consonant with Applicant's elected invention for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable, specifically:

- i) c-Src, as recited in Claim 2,
- ii) p120ctn, as recited in Claim 3,
- iii) epidermal growth factor receptor (EGFR), as recited in Claim 4,
- iv) β -catenin, as recited in Claim 5, or
- v) protein kinase C δ , as recited in Claim 6.

In the instant case, each test agent is a distinctly different signal transduction molecule, of distinctly different structure that performs a distinctly different biological function. The c-Src molecule is a cytoplasmic tyrosine kinase; whereas, the β -catenin is an integral component of the cadherin complex that links cadherins to the actin cytoskeleton, for example. Each protein consists of distinctly different amino acid motifs and protein-protein binding domains that regulate the activity of the respective molecule, as well as its ability to associate with other molecules in the cell, such as MUC1. The means by which β -catenin binds to MUC1 is mutually

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exclusive of the means by which c-Src or EGFR binds to MUC1. Furthermore, a compound that inhibits the binding of MUC1 to p120ctn will not necessarily inhibit the binding of MUC1 and protein kinase C δ . Similarly, a compound that inhibits the binding of MUC1 to EGFR will not necessarily inhibit the binding of MUC1 and β -catenin. Thus, each test agent will yield distinctly different effects.

A search for one type of signal transduction molecule would not be co-extensive with a search for another type of signal transduction molecule. Further, a reference rendering c-Src as anticipated or obvious over the prior art would not necessarily also render p120ctn as anticipated or obvious over the prior art. Similarly, a finding that EGFR was novel and unobvious over the prior art would not necessarily extend to a finding that protein kinase C δ was also novel and unobvious over the prior art. Because these inventions are distinct for reasons given above, and because a search of one does not necessarily overlap with that of another species, it would be unduly burdensome for the examiner to search and examine all the subject matter being sought in the presently pending claims and thus, restriction for examination purposes as indicated is proper.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed test agent, even though this requirement is traversed. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election. Failure to elect a test agent consonant with Applicant's elected Invention, may result in a notice of non-responsive amendment.


Should Applicant traverse on the ground that the species are not patentably distinct, Applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin K. Hill, Ph.D. whose telephone number is 571-272-8036. The examiner can normally be reached on Monday through Friday, between 9:00am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on 571-272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



DAVE TRONG NGUYEN
SUPERVISORY PATENT EXAMINER